

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/015,967	EATON ET AL.	
	Examiner Dong Jiang	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to the supplemental amendment filed on 11/16/06.
2.  The allowed claim(s) is/are 36-39 and 41-45 to issue as claims 1, 2, 5-7, 3, 4, 8 and 9, respectively.
3.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some\*
  - c)  None
  - of the:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a)  including changes required by the Notice of Draftperson's Patent Drawing Review ( PTO-948) attached
    - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_\_.
  - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1.  Notice of References Cited (PTO-892)
2.  Notice of Draftperson's Patent Drawing Review (PTO-948)
3.  Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 11/16/06
4.  Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5.  Notice of Informal Patent Application
6.  Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7.  Examiner's Amendment/Comment
8.  Examiner's Statement of Reasons for Allowance
9.  Other \_\_\_\_\_.

GARY B. NICKOL, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

## **DETAILED OFFICE ACTION**

Applicant's supplemental appeal brief filed on 31 August 2005 is acknowledged.

Applicant's supplemental amendment filed on 16 November 2006 is acknowledged and entered. Following the amendment, claims 33-35 are canceled, claims 36, 37 and 42 are amended, and the new claims 44 and 45 are added.

Currently, claims 36-39 and 41-45 are pending and under consideration.

### **Withdrawal of Objections and Rejections:**

All objections and rejections of claims 33-35 are moot as the applicant has canceled the claims.

The prior art rejection of claims 36-39 and 41-43 under 35 U.S.C. 102(b) as being anticipated by Lal et al., WO 200000610-A2 (06 January 2000), is withdrawn for the reasons below.

### **Formal Matters:**

#### ***Information Disclosure Statement***

Applicant's IDS submitted on 11/16/2006 is acknowledged and has been considered. A signed copy is attached hereto.

#### ***Drawings***

This application lacks formal drawings, for example, Figures 3-5 and 9. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant is required to submit new formal drawings.

Appropriate correction is required.

#### **Examiner's Comment**

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Upon further consideration, the Examiner decided to withdraw the prior art rejection of the present claims under 35 U.S.C. 102(b) as being anticipated by Lal et al., WO 200000610-A2 (06 January 2000), for the following reasons:

The Lal reference discloses a polypeptide, a human signal peptide-containing protein having an amino acid sequence of SEQ ID NO:94, which is 100% identical to SEQ ID NO:2 of the instant invention. However, the reference does not disclose any functional property or biological significance of the polypeptide.

The present application discloses the polypeptide of SEQ ID NO:2 (PRO842), and teaches that the PRO842 polypeptide of SEQ ID NO:2 is an IL-8 homolog, and is indicated a role in chemoattracting monocytes and dendritic cells (Example 13).

In view of the case law, *In re Moore*, 170 USPQ260 (CCPA 1971), and *In re Stempel*, 113 USPQ 77 (CCPA 1957), which indicate that applicants need only demonstrate in a declaration under 37 CFR 1.131 that portion of applicants invention that appears in the prior art cited reference; and in view of the instant situation where both applicants and the Lal reference disclosed the sequences, and applicants have the earlier date in terms of disclosing the sequence (60/090,696 filed on 6/25/98) although the functional activity of the polypeptide was not disclosed until the present application (filed on 12/7/01), the above mentioned prior art rejection is withdrawn.

**Conclusion:**

Claims 36-39 and 41-45 are allowed.

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**Advisory Information:**

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Dong Jiang, Ph.D.  
Patent Examiner  
AU1646  
1/16/07

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